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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/382,423	08/24/1999	JEFFRY JOVAN PHILYAW	PHLY-24.739	5217

25883 7590 05/20/2005

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EXAMINER	
BROWN, RUEBEN M	
ART UNIT	PAPER NUMBER
2611	

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/382,423	PHILYAW ET AL.	
	Examiner	Art Unit	
	Reuben M. Brown	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 September 0204*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4,5 and 7-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-2, 4-5 & 7-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to the claims have been considered but not persuasive.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2 & 8-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Kitsukawa, (U.S. Pat # 6,282,713).

Considering amended claim 1, the claimed method for delivering advertising to a consumer over a broadcast media/global communication network, comprising the steps of generating an advertisement broadcast comprised of a general program having non-

advertisement content and associated advertising dispersed there through for broadcast over a broadcast media which is directed to a general class of consumers, reads on Kitsukawa which teaches that icons or objects that represent advertisements may be presented to a TV viewer during the display of a particular TV broadcast, (Abstract; col. 6, lines 40-53; col. 7, lines 25-35 & Fig. 5). The regular TV broadcast in Kitsukawa corresponds with the claimed non-advertisement content.

The claimed feature of embedding in the broadcast unique information for inducing a consumer to access a desired advertiser's location on the global network over a PC based system reads on Kitsukawa providing viewers with the advertisements that enable the viewer to connect with catalogs/web sites of manufacturers and dealers, (col. 8, lines 50-67). Also, the additionally claimed feature of broadcasting to the potential class of consumers, the advertisement broadcast with the embedded unique information therein, reads on transmitting the video broadcast along with the URL links which enables the users to access corresponding web pages or the links which enables connection to an electronic database.

Regarding the amended claimed feature of dispersing the unique information throughout the program broadcast at different places, such that the viewer is induced by at least a portion of the received unique information to access the desired advertiser's location after a predetermined time in the broadcast and wherein the location of the unique information in the program broadcast is associated with the content of the program broadcast proximate in time thereto, Kitsukawa teaches that the advertising links may be associated with specific actors, actresses or

by associating with icons that represents content; see col. 8, lines 51-67 thru col. 9, lines 1-10 & Fig. 5.

As for the information being at predetermined times, since Kitsukawa teaches that advertising data may be multiplexed with the program before it is broadcast, and the viewer is provided with an alert that informs the viewer that an advertising will be available, Abstract; col. 7, lines 10-20, the reference reads on the claimed subject matter.

Regarding the additionally claimed feature of, 'wherein the unique information that is provided at different times in the general broadcast associated with the step of accessing comprises either a first portion for informing the consumer that an access will be available at another time or a second portion that is delivered to the consumer at another desired time for allowing the user to access the desired advertiser', Kitsukawa teaches that the advertisements may be stored for later retrieval or recall by the user, see col. 6, lines 54-60; col. 7, lines 45-60; col. 8, lines 1-15 & col. 9, lines 51-67. Thus Kitsukawa at least reads on informing the consumer that an access will be available at another desired time, since the storage mode in Kitsukawa informs the user that the advertisement may be retrieved or recalled at a later time.

Considering claim 2, the claimed method step of activating a network or server at the advertiser's location to wait for a response in the form of a network connection to the advertiser's location by a potential consumer, and upon a response from one of the consumers providing information additional to that contained within the advertisement broadcast, reads on the operation of Kitsukawa, wherein a user may select an advertisement that contains a web page or

catalog link that connects the user to a manufacturer or dealer, col. 8, lines 51-60. Additional web pages are transmitted to the consumer, in response to requests for the instant web pages, by the well-known process of selection of icons, buttons, interactive images, etc.

Considering claim 8, Kitsukawa discusses numerous methods for indicating that a selectable entity is available, including the use of audible tones, col. 7, lines 11-15 & col. 8, lines 27-31.

Considering claim 10, Kitsukawa discusses numerous methods for indicating that a selectable entity is available, including the use of audible tones, col. 7, lines 11-15 & col. 8, lines 27-31.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 4-5, 7, 9 & 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitsukawa, in view of Marsh, (U.S. Pat # 5,848,397).

Considering claims 4-5 & 7, Kitsukawa does not explicitly discuss embedding information in the advertisement that can be decoded by the PC and transferred back to the advertiser's location upon access thereof by the consumer. Nevertheless, Marsh teaches at least embedding an identification code or number, for the purpose of tracking the number of times and by which consumers the instant commercial has been accessed; see col. 14, lines 20-23 & col. 14, lines 65-67 thru col. 15, lines 1-40. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Kitsukawa with the feature of embedding at least ID information in an advertisement, at least for the desirable benefit of tracking statistics data regarding the instant advertisement, as taught by Marsh.

Considering claims 9 & 11, Kitsukawa does not explicitly discuss embedding information in the advertisement that can be decoded by the PC and transferred back to the advertiser's location upon access thereof by the consumer. Nevertheless, Marsh teaches at least embedding an identification code or number, for the purpose of tracking the number of times and by which consumers the instant commercial has been accessed; see col. 14, lines 20-23 & col. 14, lines 65-67 thru col. 15, lines 1-40. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Kitsukawa with the feature of embedding at least ID information in an advertisement, at least for the desirable benefit of tracking statistics data regarding the instant advertisement, as taught by Marsh.

Response to Arguments

6. Applicant's arguments filed 9/17/2004 have been fully considered but they are not persuasive. Applicant argues that Kitsukawa does not show the features recited in the 'second portion that is delivered to the consumer...'. However, it is pointed out that the amended claimed 1, recites 'comprises either a first portion...or a second portion...', thus it is only necessary to meet either limitation to meet the claim. Kitsukawa teaches that the user is given the option of storing an advertisement for later recall, which clearly reads on 'informing the consumer that an access will be available at another desired time'.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

or faxed to:
(703) 872-9306, (for formal communications intended for entry)
Or:
(703) 746-6861 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F (9:00-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (571) 272-7294. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9306 for regular communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Reuben M. Brown